

Remarks/Arguments

Claims 1-15 and 17-30 are pending in the application. Claims 1-15 and 17-30 are rejected. Claim 16 was previously cancelled. Claims 1, 2, 3, 4, 9, 15, 17, 27, 28 and 29 are currently amended.

Applicant amends claims 1, 2, 3, 4, 9, 15, 17, 27, 28 and 29 to clarify the subject matter therein claimed. Applicant further submits that these amendments add no new matter. Support for the amendments of claims 1 and 4 may be found, for example, in the specification in paragraph [0011], [0012], [0015], [0016], [0019], [0025], and [0028] and in Figures 1 and 3A of the published application. Support for the amendment of claim 2 may be found, for example, in Figures 1 and 3A and 3B. Support for the amendment of claim 3 may, for example, be found in the specification in paragraph [0026]. Support for the amendment of claim 9 may be found in the specification in paragraph [0034], for example. Support for the amendment of claims 15, 17, 27, 28, and 29 may, for example, be found in the specification in paragraphs [0012], [0017], [0030], and Figure 1. Support for the amendment of claim 27 may be found in the specification in paragraph [0033], for example.

Applicant notes that the claim set, as amended, does not add new claims and as such no excess fees are due.

Applicant further notes that this Amendment and Response is being filed within three months beyond the three month shortened statutory period, and as such, an extension of three months is requested, pursuant to 37 CFR 1.136. Any fees that become due may be charged as set forth below.

An Information Disclosure Statement is being concurrently filed herewith. The Information Disclosure Statement fee under 37 C.F.R. §1.17(p) is authorized below.

Claim Rejections -35 U.S.C. §102: The Action rejects claims 1 and 2 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 1,103,465 ("Arrowsmith")

As to claims 1 and 2, the Action states that Arrowsmith discloses a bunion shield and corrector that anticipates the claimed invention. Applicant respectfully traverses this rejection. Arrowsmith discloses a sole piece A provided with upright hollow posts B and C adapted to receive a filling of cotton or other suitable substance to give the posts a certain degree of elasticity, as described in lines 46-52. Besides cotton, no other suitable materials are disclosed. A filling made of cotton or similar material, is structurally and functionally different from the insert claimed. The filling described in Arrowsmith does not provide the ease of width adjustability that the claimed inserts have. A cotton filling will not provide the consistent and uniform spacing that the claimed inserts provide. In the claimed invention the columns are provided with an insert that conforms to the recess, as described in paragraph [0025] of the pending application. Additionally, the insert provides sufficient hardness to hold apart adjacent toes (see paragraph [0034]) and may have slightly more rigidity than the material from which the columns are formed (see paragraph [0016]). Therefore, the filling described in Arrowsmith is distinguishable over the insert of defined width that is claimed.

Applicant further submits that the current amendment to independent claim 1, to recite a column having a generally cylindrical hour-glass shape, render the claims patentably distinguishable over the Arrowsmith, which does not have such feature.

Accordingly, claim 1 is patentably distinct over Arrowsmith for any one or more of the foregoing reasons.

The Action rejects claims 1, 4, 8, 9, 15, 17, 27 and 28 as anticipated by U.S. Patent No. 853,327 ("Wall").

As to claim 1, the Action states that Wall discloses inter-digital columns that are width-adjustable. Wall, however, discloses one or more tubes to hold a pair of toes separated. As

described on page 2, lines 13-16, of Wall, the two tubes 10 and 11 are in parallel relation to each other and do not create two or more inter-digital interconnected columns "between at least two pairs of adjacent toes." Accordingly, the two tubes cannot be considered inter-digital columns as claimed because they are between only a single pair of toes.

Additionally, Wall discloses tubes that are cylindrical and does not have columns that have a generally cylindrical hour-glass shape.

Accordingly, claim 1 is patentably distinct over Wall for any one or more of the foregoing reasons.

As to claim 4, the hollow tubes disclosed in Wall do not provide the advantages of comfort and fit of the cylindrical hour-glass shape of the columns of the claimed invention. In Wall, the hollow tubes are not preformed in a concave shape and would seem to cause pressure points. The claimed columns, however, have a form-fitting, generally cylindrical hour-glass shape including cross-sectionally concave sidewalls. Therefore, claim 4 is patentably distinct over Wall.

Claims 8 and 9 depend from claim 4, which is distinguishable over Wall, as argued above. Additionally, as to claim 9, Wall does not disclose an insert formed of a polymer, i.e., a soft, durable, shape-retentive polymeric material of sufficient hardness to urge and hold apart in predetermined width (or angular) relationship one or more pairs of adjacent toes, as described in paragraph [0034] of the application. In contrast, the tubes disclosed in Wall have a filling of cotton or unspecified "suitable" matter.

As to claims 15 and 17, Wall does not disclose two or more inter-digital interconnected spacers for two or more pairs of adjacent toes, as argued above. Additionally, the retainer, disclosed in Wall, is positioned between a single pair of toes only and does not have an interconnecting web structure to produce a toe channel, as claimed in claims 15 and 17, i.e., one or more interconnecting web structures fixedly attached to and extending across the upper

and lower regions of the two or more spacers to fix the spacers relative to one another in a generally parallel configuration to produce a toe channel. Furthermore, regarding claim 17, the cotton filling disclosed in Wall is different from the inserts claimed, which are dimensioned to widen the recess and the column.

As to claims 27 and 28, Wall does not disclose a method which includes adjusting the width of the spacers by incorporating inserts into the spacers. Additionally, regarding claim 28, Wall describes a filling of cotton or unspecified "suitable material." Wall does not disclose the use of shims to adjust the width of the spacers and wherein the adjusting includes selecting and inserting shims of predetermined width into corresponding recesses formed within the bodies of the spacers.

For the foregoing reason, Applicant respectfully submits that independent claims 1, 4, 15 and 17, and all dependent claims thereto, are patentably distinguishable over Arrowsmith and Wall.

The Action further rejects claims 4, 6, 10, 12 and 14 as anticipated by U.S. Patent No. 1,080,304 ("Scholl"). Claims 6, 10, 12 and 14 all depend from claim 4, which is generally directed to an orthotic toe spacer including an insert in a recess of a column. The insert disclosed in Scholl is a single cylindrical, resilient plug that is retained in a retaining seat portion of the oval wall 12, as described on lines 70-78. As further described on lines 65-75 of Scholl, the ovate wall 12 is provided with vertical stiffening ribs 13 to resist deflection at that point to a greater extent than do the thinner walls in rear of the ribs. Said ribs are preferably dished on their inner surfaces to form in each separate side wall a retaining seat portion in which a plug or post may be fitted to be retained against displacement longitudinally of the spreader. Thus, the plug in the retaining seat portion is held in a front part of the ovate wall 12, and does not cover the entire recess formed by the ovate wall. In contrast, the insert, claimed in claim 4, is fitted into the recess of a column and fixedly gripped thereby. Moreover, the recess and the insert are

generally isometric and isomorphic to one another, i.e., the recess and insert are shape and dimension conforming. This conformity ensures straightforward insertion and removal of the insert into and from the recess while providing excellent retention of the insert within the recess (see paragraph [0025]). In Scholl, the plug is not shape and dimension conforming to the ovate wall, since the plug is retained in the front part of the oval recess only, while the back part of the recess is empty. Therefore, the plug disclosed in Scholl is different from the insert claimed.

As to claim 6, in addition to the arguments above, the pneumatic cushion disclosed in Scholl is not pressure-adjustable. The plug described in Scholl is a closed air-containing cylinder having a resistance depending upon the inflation of the cushion. The bladder of the claimed invention is pressure-adjustable, i.e., the bladder may be pumped up or down to a desired volume or and pressure to adjust the width of the inter-digital spacing, as described in paragraph [0026].

As to claim 12, which depends on claim 4, the oval disclosed in Scholl has ribs 13 to form a distinct retaining seat portion for a plug or post. This is different from the claimed insert and recess, which are generally isometric and isomorphic to one another.

For any one or more of the foregoing reasons, Applicant respectfully submits that independent claim 4 and all dependent claims thereto, are patentably distinguishable over Scholl.

Claim Rejections -35 USC §103: Applicant confirms that the subject matter of the various claims was commonly owned by the inventors at the time any inventions covered therein were made. The Action rejects claims 3, 5, 11, 13, 18-25 and 29 as unpatentable over Wall. Applicant respectfully disagrees with the rejection.

Applicant submits that the Action does not establish a *prima facie* case for rejection of the claims. The Action asserts that Wall discloses the spacer of claims 1 and 4. Applicant

respectfully disagrees for reasons set forth below. Additionally, Applicant submits that the amendments render moot the rejections.

Regarding claim 3, the Action states that Wall discloses that the column itself can be converted into a pressurizable bladder. However, a claim cannot be obvious unless the combination of references together discloses each and every element of the claimed invention. As discussed above, Wall does not disclose claimed elements. Therefore, the combination referred to in the Action cannot result in the claimed invention.

As to claim 5, the Action asserts that it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide sufficient sized pieces of cotton or suitable matter in order to vary the degree of rigidity as needed. The shims or inserts of the claimed invention are distinguishable over the cotton filling used in the prior art, because such a cotton filling does not provide the isometric and isomorphic features that the claimed shims provide. Additionally, Wall does not disclose that the filling material is selected from a group of shims of various widths. Therefore, it would not have been obvious to one having ordinary skill in the art at the time the invention was made to arrive at the shims that are currently claimed.

Regarding claims 11 and 13, which depend of claim 4, Wall does not disclose each and every element of the claimed invention, as argued above, and therefore the Action does not establish a *prima facie* case of non-patentability. Furthermore, Wall does not disclose tabs extending radially from a center. Any tabs attached to cotton filling may not remove the entire filling. Also, as claimed in claim 13, the recess and insert are isomorphic and isometric to one another. In contrast, the tubes and filling disclosed in Wall adjust to each other only under the pressure of the toes.

For the same reasons as argued above, no *prima facie* case is established for claims 18-25 because these claims depend, either directly or indirectly, on claim 17 and not each and every element of the claimed invention is disclosed.

The Action further rejects claim 7, as unpatentable over Scholl. Applicant respectfully disagrees with the rejection. As argued above with regards to claim 6, Scholl does not disclose a pressure-adjustable bladder, and therefore, the Action does not establish a *prima facie* case of non-patentability.

Claims 26 and 30 are rejected as being unpatentable over Wall in view of Scholl. As argued above, Wall does not disclose the apparatus claimed, i.e., integrally molded web structures. The fastener disclosed in Sholl is not suitable for holding a web structure in position. Therefore, it would not have been obvious to one having ordinary skill in the art to arrive at the apparatus claimed and there is no *prima facie* case of obviousness from the combination of references.

In view of the foregoing, applicant requests that the Action's rejections be reconsidered and withdrawn.

Nothing herein should be deemed as a disclaimer or surrender of any rights, an acquiescence in any rejection, or a waiver of any arguments that might have been raised but were not raised herein or otherwise in the prosecution of this application. Applicant reserves all rights and subject matter with respect to claims being or to be pursued in this or a related application.

CONCLUSION

Applicant submits that in view of the foregoing remarks and/or amendments, the application is in condition for allowance, and favorable action is respectfully requested.

The Commissioner is hereby authorized to charge any fees, including extension fees, or to charge any additional fees or underpayments, or to credit any overpayments, to the Credit Card account referenced and authorized via the EFS Web (Electronic Filing System). As an alternative, in case the Credit Card cannot be processed, the Commissioner is hereby

authorized to charge any fees, additional fees, or underpayments, or to credit any overpayments, to Deposit Account No. 50-1001.

Respectfully submitted,

Date: 01-22-08



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